

AF
3622
JW



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: SOLOMON, et al.
Serial No.: 09/470,582
Filing Date: December 22, 1999
Confirmation No. 6338
Group Art Unit: 3622
Examiner: James W. Myhre
Title: REBATE PROCESSING SYSTEM AND METHOD
PROVIDING PROMOTIONS DATABASE AND
INTERFACE

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Express Mailing Label Number
EV 473957646 US
I hereby certify that this paper or fee is being
deposited with the United States Postal Service
"Express Mail Post Office to Addressee" service
under 37 CFR 1.10 on the date indicated below
and is addressed to Commissioner for Patents,
P.O. Box 1450, Alexandria, VA 22313-1450.

Willie Jiles

Willie Jiles

Date of Deposit: Nov. 1, 2004

Reply Brief

Appellants have appealed to this Board from the decision of the Examiner, contained in a final Office Action mailed February 12, 2004 (the "Final Office Action"), finally rejecting Claims 1, 2, 4-14, 16-26, 28-32, 34-38, and 40-46. Appellants mailed a Notice of Appeal on May 11, 2004. The Examiner responded in an Examiner's Answer mailed August 30, 2004 (the "Examiner's Answer"). Appellants respectfully submit this Reply Brief.

In the Examiner's Answer, the Examiner continues to rely on *Finsterwald* and *Freeman* and reiterates many of his earlier arguments with little variation - despite Appellants having demonstrated major flaws in these arguments in the Appeal Brief. The Examiner's Answer does attempt to address Appellants' analysis. However, in attempting to rebut this analysis, the Examiner's Answer simply highlights again the deficiencies of the references. In the interest of brevity, this Reply Brief will address only selected points without providing a detailed reiteration of the analysis in the Appeal Brief.

Group 1 - Finsterwald and Freeman Fail to Disclose the Rebate Request Status Aspects of the Claims

In the Appeal Brief, Appellants demonstrated that that the proposed *Finsterwald-Freeman* combination fails to support the rejection of Appellants' claims for at least two reasons. First, the *Finsterwald-Freeman* combination fails to teach or suggest all elements of the claims. Second, the combination of *Finsterwald* and *Freeman* is improper. With respect to the first point, Appellants pointed out two aspects of the claims conspicuously absent from the teachings of *Finsterwald* and *Freeman*. One of these two aspects involves the claimed requirement for a database maintaining rebate request statuses for a number of transactions and a processor for providing rebate status updates to consumers using the rebate request statuses.

For teaching of the rebate request status aspects of the claims, the Final Office Action relied on the disclosure of codes in *Finsterwald*. Appellants showed in the Appeal Brief that the discussion of these codes failed to teach or suggest the rebate request status aspects of the claims. The Examiner clarifies his position in the Examiner's Answer, but this discussion only serves to expose fundamental misconceptions underpinning the rejection. The Examiner's Answer argues that the *Finsterwald* system discloses a database maintaining status for rebate requests, stating that: "Finsterwald does disclose maintaining a database of pending and redeemed rebate codes, disclosing at least two status states for the rebate." *Examiner's Answer*, at page 10. However, *Finsterwald*'s database only maintains a list of valid codes; this database does not maintain redeemed codes.¹ Therefore, the basic premise

¹ See *Finsterwald* at column 9, lines 36-61, which states: "[To check for a valid code], the transmitted code is compared with the codes stored in the reference memory 4. If the transmitted code is present in the reference memory 4, then this is a valid code. Otherwise the code is invalid. . . . After a code transmitted by the customer 14 has been recognised as valid, this code is cancelled in the reference memory 4 to avoid the code being

of the Examiner's argument fails and so too must the Examiner's rejection. In short, *Finsterwald* fails to teach or suggest any database maintaining status of rebate requests as required by the claims.

The Examiner's Answer continues with yet another flawed argument with respect to *Finsterwald*. Specifically, the Examiner's Answer proposes that, to obtain status for a rebate request, a customer "would enter the rebate code in question and receive the status back from the database." *Examiner's Answer*, at page 10. However, this proposed operation would simply amount to a customer repeatedly requesting point credits by submitting the same code. *Finsterwald* itself rebuts the Examiner's position in addressing this very operation, stating that: "After a code transmitted by the customer 14 has been recognised as valid, this code is cancelled in the reference memory 4 to avoid the code being recognised a second time as a valid code should the customer, for example, send the same code to the data collecting station 1 again." *Finsterwald*, at column 9, lines 56-61. Therefore, even assuming for arguments sake that a customer did resort to repeatedly submitting the same code, this would merely result in a series of failed requests for points. These repeated attempts to use the same code would not tell the user whether the code was ever valid, whether any points were ever credited based on the code, to whom any potential points may have been credited, a status for any outstanding rebate requests, or anything else that reflects rebate status information associated with a particular product purchase. These teachings of *Finsterwald* certainly fail to show a database maintaining transaction information that, for a particular product purchase, comprises a consumer identifier, a rebate request status, and a promotion identifier matching to a promotion, and a processor capable of providing rebate status updates to a consumer using the rebate request status.

Therefore, the reliance on *Finsterwald* for teaching the claimed status update aspects fatally flaws the arguments in the Examiner's Answer. However, the preceding focus on only the rebate request status update aspects of the claims should in no way be taken as a concession that the references teach any of the other claimed aspects, such as the rebate promotion report aspects. Also, Appellants continue to maintain that the combination is improper. However, the Examiner's Answer merely reiterates earlier positions, and thus Appellants have not provided a detailed restatement of the analysis from the Appeal Brief.

recognised a second time as a valid code should the customer, for example, send the same code to the data collecting station 1 again."

Appellants again respectfully request the Board to direct the Examiner to allow Claims 1, 2, 4-14, 16-26, 28-31, and 40-46.

Group 2 - The Examiner has Failed to Make a *Prima Facie* Case of Obviousness

In the Appeal Brief, Appellants addressed three specific reasons why the Board should reverse the Examiner's rejection of Claims 32 and 34-38. First, the Final Office Action completely failed to present any evidence of obviousness with respect to these claims and thus failed to establish a *prima facie* case of obviousness. Second, assuming for arguments sake that the Examiner had established a *prima facie* case of obviousness, the *Finsterwald-Freeman* combination fails to teach or suggest all elements of Claims 32 and 34-38. Third, once again assuming for arguments sake that the Examiner had established a *prima facie* case of obviousness, the combination of *Finsterwald* and *Freeman* is improper. The Examiner's Answer has failed to remedy any of these deficiencies.

With respect to the most glaring deficiency, the absence of any evidence of obviousness, the Examiner's Answer makes a halfhearted attempt to cure this failure with several conclusory statements. However, these statements address virtually none of the substantive limitations in Claim 32. For example, consider the limitations of a computer-based interface for facilitating rebate processing operable to:

receive promotion information for the promotion, the promotion information comprising a product identifier and a plurality of disbursement options for receiving an authorized rebate, at least one of the disbursement options having a cash value to a recipient different than another one of the disbursement options [and] communicate promotion information to a remote rebate processing center.

As teaching of these aspects of Claim 32, the Examiner's Answer states:

Finsterwald discloses that the offerees (users) generate the specific codes, which include such information as the nature of the product, the place of production, the time of production, etc. (col 3, lines 2-6 and 63-67), and then transmits these codes (and the information) to a central position (data collection station. [sic]

Examiner's Answer, at page 14 (underline in original). Limitations such as the plurality of disbursement options are notably absent from this statement and the identified description in

Finsterwald. Further consider the additional limitations of the computer-based interface of Claim 32 operable to:

receive a status of the promotion based on purchases of the product, the status indicating a number of rebate requests for the promotion and a number of authorized rebates fulfilled for each of the disbursement options for the promotion.

As teaching of these aspects of Claim 32, the Examiner's Answer states:

[These aspects of the claim are] disclosed by Finsterwald as the data collecting station storing the time of data transmission by the customer which the manufacturer can use to determine "the amount of time which elapses between the manufacture and the sale of the product" (col 5, lines 25-30).

Examiner's Answer, at page 15 (underline in original). Limitations such as the status of the promotion are notably absent from this statement and the identified description in *Finsterwald*.

Upon review, these statements in the Examiner's Answer appear almost random in light of the specific limitations in Claim 32. Moreover, an examination of the cited portions of *Finsterwald* fails to provide any clarification of the Examiner's statements or his reliance on *Finsterwald* for the rejection of Claim 32. In short, the Examiner's assertions do not remedy the failure to establish a *prima facie* case of obviousness. Therefore, Appellants again request the Board to direct the Examiner to allow Claim 32 and its dependent Claims 34-38.

Conclusion

Appellants have demonstrated that the present invention, as claimed, is clearly patentable over the prior art cited by the Examiner. Therefore, Appellants respectfully request the Board to reverse the final rejections and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

Although Appellants believe no fees are due, the Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS, L.L.P.
Attorneys for Appellants

A handwritten signature in black ink, appearing to read 'Kurt M. Pankratz', with a long horizontal stroke extending to the right.

Kurt M. Pankratz
Registration No. 46,977

Date: November 1, 2004

Customer Number: **05073**